



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/152,458	09/14/98	MAIER	R 30866

PM32/0217
PEARNE GORDON MCCOY & GRANGER
1200 LEADER BUILDING
CLEVELAND OH 44114

EXAMINER

COHEN, C

ART UNIT PAPER NUMBER

3634

DATE MAILED: 02/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/152,458

Applicant(s)

Maier

Examiner

Curtis Cohen

Group Art Unit

3634



☒ Responsive to communication(s) filed on Sep 14, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3634

DETAILED ACTION

This application repeats a substantial portion of prior Application Nos. 09/009,641, 08/866,230 and 08/654,597, filed January 20, 1998, May 30 1997 and May 29, 1996 respectively, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.d. 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are rejected under the judicially created doctrine of double patenting over claims 1-14 of U. S. Patent No. 5,669,180 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Art Unit: 3634

Claims 1-19 are rejected under the judicially created doctrine of double patenting over claims 1-8 of U. S. Patent No. 5,829,196 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a retaining flange having a camming surface. The camming surface is the rounded or curved-edge middle flange.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a retaining flange having a camming surface. The camming surface is the rounded or curved-edge middle flange.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Art Unit: 3634

Claim Rejections - 35 USC § 112

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 1, 10 and 19, applicant recites the term "rearward" is a relative term which renders the claim indefinite. Applicant has not set forth where "rearward" is with respect to a structural feature.

Claim 4, applicant has recited the term "increasing" in line 2. This is a comparative term that has not been compared to anything. That is, "increasing" with respect to what?

Claim 1, line 7, the term "retainers at the side walls" is ambiguous. Does this language means that they are connected to the side walls or just nearby? Perhaps using the preposition --on-- in place of "at" would clarify this ambiguity.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 6-13, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Schultz #5,139,291. Schultz discloses a housing having side walls, a top wall, retainers 8 extending from the side walls and defining a camming surface. With respect to claim 5, in Figure

Art Unit: 3634

5 of Schultz, the top surface of the flange is parallel to an outer portion of the upper surface formed by retainer 8 and extending from the side wall. The engagement surface is the inner portion of the upper portion formed by the retainer 8 and extending from the side wall. That is, the upper surface formed by retainer 8 is one continuous surface, however the examiner is interpreting the outer half of the continuous surface to be a lip and the inner half of the surface to be an engagement surface.

Claims 1, 2, 5-19 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art in Figures 10 and 11. Applicant discloses a housing having side walls, a top wall, retainers extending from the side walls, a rear wall and the bottom wall and defining a camming surface. With respect to claim 5, the top surface of the flange is parallel to an outer portion of the upper surface formed by retainer 8 and extending from the side wall. The engagement surface is the inner portion of the upper portion formed by the retainer 8 and extending from the side wall. That is, the upper surface formed by retainer 8 is one continuous surface, however the examiner is interpreting the outer half of the continuous surface to be a lip and the inner half of the surface to be an engagement surface.

Claim Rejections - 35 USC § 103

Claims 4 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz as applied to claims 1, 2, 5, 6-13, and 16-19. Schultz discloses the invention as discussed in the Section 102 rejection above. Schultz does not disclose an arcuate surface as recited in claim 3. It

Art Unit: 3634

would have been an obvious matter of design choice to use an arcuate surface thereby decreasing the amount of material needed in manufacturing the sides.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Slocumb et al are cited for their teaching of a pivot bar housing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen

February 12, 1999



Daniel P. Stodola
Supervisory Patent Examiner
Group 3600